REMARKS

Priority

The specification has been amended to add priority information. The executed Supplemental Declaration is submitted herewith. Applicants have also attached herein an initial Application Data Sheet (ADS) and a Supplemental ADS. The Supplemental ADS provides a claim to priority to both provisional applications U.S. Ser. No. 60/172,226 and 60/131,321.

Status of Claims

By the above amendment, Claims 1-20 have been cancelled without prejudice or disclaimer. New Claims 21-44 have been added.

Restriction Requirement

Applicants hereby elect, with traverse, to prosecute Group XXV, which includes and is drawn to new Claims 24-30 and 32-33, which correspond to original Claims 3-6 and 9-13. Further, Applicants elect, with traverse, to prosecute claims related to the polynucleotide sequences encoding the polypeptide sequence of SEQ ID NO:11, which sequences include SEQ ID NO:27.

Applicants traverse the restriction requirement which was imposed in the Office Action mailed August 20, 2003 for at least the following reasons.

Applicants reserve the right to prosecute the non-elected subject matter in subsequent divisional applications.

The unity of invention standard ***must*** be applied in national stage applications

Section 1850 of the Manual of Patent Examining Procedure (original 8th edition, published August, 2001) (hereinafter "MPEP") provides:

> ... [W]hen the Office considers international applications ... during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111....
>
> In applying PCT Rule 13.2 to ... national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of

> invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2....

Id at page 1800-60 to -61.

MPEP section 1893.03(d) reiterates the Examiner's obligation to apply the Unity of Invention standard PCT Rule 13.2 instead of U.S. restriction/election of species practice:

> Examiners are reminded that unity of invention (not restriction) practice is applicable ... in national stage (filed under 35 U.S.C. 371) applications.

Id at page 1800-149, column 1.

Specific provisions of the Administrative Regulations Under the PCT and the corresponding provisions of the MPEP strongly support a finding of unity of invention among all of the claims in the present case

Unity of Invention is accepted as between claims to polypeptide sequences and claims to the polylnucleotide sequences which encode them

Example 17, Part 2 of Annex B to the Administrative Instructions Under the PCT provides that unity of invention is accepted as between claims to polypeptide sequences and claims to polynucleotide sequences encoding those polypeptides. Those Examples are cited in MPEP section 1893.03(d) at page 1800-149, column 2 ("[n]ote also examples 1-17 of Annex B Part 2 of the PCT Administrative Instructions...")

Thus, in the present case, unity of invention exists at least as between claims drawn to polypeptides comprising the sequence of SEQ ID NO:11 (*i.e.*, Claims 21-23 and 37) and as to claims drawn to polynucleotide sequences which encode those polypeptides (*i.e.*, Claims 24-30 and 32-33).

Therefore, Applicants respectfully request that the Examiner withdraw the Restriction Requirement at least as to claims 21-30, 32-33 and 37, and examine those claims in a single application.

Unity of invention exists as between all of Applicants' claims

MPEP 1850 provides:

> Unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more special technical features. The term "special

technical features" is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art. The determination is made based on the contents of the claims as interpreted in light of the description and drawings. Annex B also contains examples concerning unity of invention.

Id at page 800-61.

MPEP 1893.03(d) similarly provides:

> A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art. For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key. Note also examples 1-17 of Annex B Part 2 of the PCT Administrative Instructions as amended July 1, 1992 contained in Appendix AI of the MPEP.

Id at page 1800-149.

In the present case, unity of invention exists among all of Applicants' claims. The claimed polypeptide sequences and the claimed polynucleotide sequences encoding them are corresponding technical features which are common to all of Applicants claims, which serve to technically interrelate all of Applicants' claims, and which define the contribution over the prior art made by each of them. Furthermore, antibody Claim 31 is technically interrelated to the polypeptide claims since that claim recites an antibody which specifically binds, *inter alia*, a polypeptide comprising the amino acid sequence of SEQ ID NO:11. Thus, Applicants' claims are linked to form a single general inventive concept, and Applicants are therefore entitled to prosecute all of their pending claims in a single national stage application.

The sequences of the claimed polypeptides and the claimed polynucleotides encoding those polypeptides, are corresponding technical features that are common to all of Applicants' claims and that serve to technically interrelate them

The sequences of the claimed polypeptides and corresponding polynucleotides are common to all of Applicants' claims, given that each claim refers to one or both either explicitly or implicitly, by virtue of depending from a claim which makes an explicit reference to the sequences of the claimed polypeptides or claimed polynucleotides.

Moreover, the sequences of the claimed polypeptides and corresponding polynucleotides serve to technically interrelate all of Applicants' claims. Applicants' composition of matter claims are drawn to either the polypeptides or polynucleotides themselves (claims 21-23 and 37, drawn to polypeptides, and 24-29, and 32-33, drawn to polynucleotides), to compositions of matter which comprise the polypeptides or polynucleotides as one element (28-29, and 44, drawn to recombinant polynucleotides, transformed cells and microarray, respectively, and 37, drawn to compositions), or to compositions of matter wherein the sequences of the claimed polypeptides functionally define the claimed subject matter (Claims 31, drawn to an antibody which specifically binds a polypeptide of claim 21).

In Applicants' method claims 30, 34-36, and 38-43, the recited polypeptides or polynucleotides serve as either the product of the claimed method (e.g. claim 30, drawn to a method of polypeptide production) and/or as a reagent for performing the method (*e.g.* claims 34-36 drawn to methods of detecting a target polynucleotide in a sample; claim 40, drawn to a method of screening for a compound that specifically binds to a polypeptide of claim 21; claim 42, drawn to a method of screening a compound for effectiveness in altering expression of a polynucleotide of claim 27; and claim 43, drawn to a method of assessing toxicity of a test compound using a polynucleotide of claim 32).

Therefore, the sequences of the claimed polypeptides and polynucleotides are corresponding technical features which are common to all of Applicants' claims, and which serve to technically interrelate them.

Rejoinder of method claims upon allowance of product claims under U.S. practice

The Examiner is reminded that claim 30 (Group X), claims 34-36 (Group LXXXV), claims 42-43, drawn to methods of using the elected polynucleotides of Group XXV should be rejoined per the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)" which sets forth the rules, upon allowance of product claims, for rejoinder of process claims covering the same scope of products. Likewise, claim 38-41, drawn to methods of using the recited polypeptides of claims 21-23, and 37 (Group X) should be rejoined.

No Undue Burden

Applicants submit that the invention encompassed by the claims of Group XXV, (drawn to polynucleotides, expression vectors, and host cells) could be examined at the same time as the invention encompassed by the claims of Group X (polypeptides variants thereof, methods of making a polypeptide, a pharmaceutical composition, and methods of use thereof) and Group XL (antibodies) without undue burden on the Examiner. For example, a search of the prior art to determine the novelty of the polynucleotides of Group XXV would reveal information regarding the novelty of the polypeptides of Group X and the antibodies of Group XL.

Applicants also respectfully submit that there is minimal additional burden on the Examiner to examine claim 30 (Group X), claims 34-36 (Group LXXXV), and claims 42-43, which are drawn to methods of using the elected polynucleotides; newly added claim 44, which is drawn to microarrays with the elected polynucleotides; and newly added claims 38-41, which are drawn to methods of using polypeptides encoded by the elected polynucleotides. The search required to identify prior art relevant to these claims should substantially overlap with that required for examination of the elected polynucleotides of Group XXV.

Therefore, Applicants respectfully request that the Examiner withdraw the Restriction Requirement and examine all the claims in a single application.

CONCLUSION

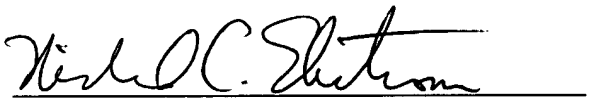
If the Examiner contemplates other action, or if a telephone conference would expedite allowance of the claims, Applicants invite the Examiner to contact the undersigned at the number listed below.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. **09-0108.**

Respectfully submitted,

INCYTE CORPORATION

Date: September 22, 2003



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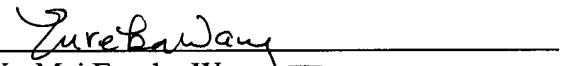

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